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EXAMINER

CHENCINSKI, SIEGFRIED E

ART UNIT	PAPER NUMBER
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3628

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/991,379

Filing Date: November 15, 2001

Appellant(s): MASCAVAGE ET AL.

Thomas D. Franklin
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed January 18, 2005

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

Appellants' brief contains a statement that there are no appeals or interferences pending in regards to this application.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

No amendment after final has been filed.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

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The rejection of claims 1-20 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

5,899,980	WILF ET AL.	705/26
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5,920,847	KOLLING ET AL.	705/40
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Microsoft Computer Dictionary, 1997, Microsoft Press, Third Edition, page 372.

Provisional Patent Application 60/186,303.

(10) Grounds of Rejection

NEW GROUNDS OF REJECTION

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 1-7, 9-15 & 17-20 are rejected under 35 U.S.C. 103(a) as being disclosed by Wilf et al (US Patent 5,899,980, hereafter Wilf).

Re. Claims 1, 10 & 17, Wilf discloses a method for authorizing and checking out from an online purchase between a customer and a vendor site/merchant system, the method comprising steps of:

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- receiving transaction information from the vendor site (Col. 2, ll. 3-15; 26-51);
- presenting a transaction amount in the new web browser window, whereby the customer can assent to the transaction amount through interaction with the new web browser window (The term “transaction detail” is an integral component of Wilf’s preferred term “transaction data” for approval by the customer/user. He uses this term throughout the reference. Examples are Col. 2, lines 30, 35, 37 and following throughout the reference. Wilf provides specific definition to the effect that a “transaction amount” is a component of this “transaction detail” as illustrated in the following locations: Col. 1, lines 27-28 and Col. 9, lines 24-29).
- receiving authorization from the customer of a debit for the transaction amount, wherein the debit corresponds to the online purchase; and notifying the vendor site of authorization (Col. 2, lines 3-15, 52 – Col. 3, line 12).

Wilf does not explicitly disclose automatically opening a new web browser window for the customer. However, Appellant admits in his argument that “the term “pop-up window” is notoriously well known” at the time of this parent application’s filing date (Appeal Brief, page 4, l. 19; p. 8, l. 6). This argument is convincing and makes moot the need for the Fung reference since it creates Appellant’s admission of the “automatically opening a new web browser window for the customer” as Appellant admitted prior art. Hence, it would have been obvious to an ordinary practitioner of the art at the time of Appellant’s invention to have combined the disclosure of Wilf with well known art to establish an automated purchasing method which includes efficient automated web based steps and conveniences for validating the payment for an online transaction without exposing the customer’s personal information by maintaining security due to the reluctance of some users to transmit credit card account information over the internet (Wilf, Col. 1, ll. 24-27).

Re. Claims 2 & 18, Wilf discloses the method for authorizing the online purchase between the customer and the vendor site wherein the new web browser window points away from the vendor site (Col. 2, lines 26-34).

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Re. Claims 3 & 11, Wilf discloses the method for authorizing and checking out from an online purchase between the customer and the vendor site further comprising a step of receiving account information from the customer corresponding to an account authorized for the debit (Col. 2, lines 34-47).

Re. Claims 4 & 12, Wilf discloses the method for authorizing and checking out from an online purchase between the customer and the vendor site wherein the new web browser window overlays an existing web browser window of the vendor site (Col. 2, lines 3-5, 47-51).

Re. Claims 5, 13 & 19, Wilf discloses the method for authorizing and checking out from an online purchase between the customer and the vendor site wherein the receiving transaction information step triggers the automatically opening step (Col. 2, lines 3-15).

Re. Claims 6, 14 & 20, Wilf discloses the method for authorizing and checking out from an online purchase between the customer and the vendor site further comprising a step of transferring payment to an account associated with the vendor site after authorization is received (Col. 7, lines 45-57).

Re. Claims 7 & 15, Wilf discloses the method for authorizing and checking out from an online purchase between the customer and the vendor site further comprising a step of presenting a message to the customer in the new web browser window indicating at least one of the following: that authorization was canceled by the customer; that authorization was rejected by a funds transfer system; and that authorization completed normally (Col. 7, line 58 - Col. 9, line 20).

Re. Claim 9, Wilf discloses a computer-readable medium having computer-executable instructions for performing the computer-implementable method for authorizing and checking out from an online purchase between the customer and the vendor site of claim 1 (Col. 1, line 63- Col. 2, line 3).

2. Claims 8 & 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wilf in view of Kolling et al (US Patent 5,920,847, hereafter Kolling).

Re. Claims 8 & 16, Wilf does not explicitly disclose a method for authorizing and checking out from an online purchase between the customer and the vendor, wherein

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the notifying step comprises a step of determining that a notification message was not received by the vendor site within a predetermined time period. However, Kolling discloses a method for authorizing and checking out from an online purchase between the customer and the vendor site wherein the notifying step comprises a step of determining that a notification message was not received by the vendor site within a predetermined time period (Col. 37, lines 2-8). It would have been obvious for an ordinary practitioner of the art at the time of applicant's invention to have combined the disclosure of Wilf with the disclosure of Kolling to establish an automated purchasing method which included a time limit for notifying a vendor of payment approval for an automated transaction in order to protect a vendor from undue delay in verifying such a transaction while minimizing costs, maintaining certain controls and discretionary actions on behalf of the biller, and simplifying the process for all the parties (Kolling, Col. 10, ll. 25-62).

Response to Arguments

A. ARGUMENT: The validity of the claimed effective filing date of February 29, 2000 (Page 4, l. 11 – page 7, l. 7).

RESPONSE: Appellant's argument and documentation is persuasive. The examiner acknowledges the date of S.N. 09/516,209 filed on February 29, 2000 as the priority date of the instant application. Thus, Fung is no longer applicable as a prior art for the instant application. In their Appeal Brief, Appellants document a convincing argument of the well known use of an automatic pop-up window in their overall argument on February 29, 200 (p. 4, l. 11 – p. 7, l. 7) to "prevent use of Fung as prior art (p. 4, l. 21). This exposition further argues that the "new" (p. 5, l. 6) and "automatically opening" (p. 5, l. 8) nature of the well known pop-up window was understood as inherent to the nature of this well known pop-up window device. It would have been obvious to the ordinary practitioner at the time of Appellant's invention to have set up the automatically opening pop-up web browser window for the customer.

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B. ARGUMENT: Whether the Parent Application Supports a Limitation in

Claims 1, 10 and 17. Appellant argues that the limitation “automatically opening a new web browser window for the customer” was well known at the time of Appellant’s effective date of invention, February 29, 2000 (Page 4, l. 11 – page 7, l. 7).

RESPONSE: This argument is accepted on the basis of being appellant admitted prior art and Appellant’s thoroughly documented support for the well known nature of this limitation.

C. ARGUMENT: Re. claims 1-7, 9-15 and 17-20, a *prima facie* case of obviousness has not been properly set forth in the final Office Action or Advisory Action (page 7, ll. 13-14) because:

1. Fung is not prior art with regard to the automatically opening of a window (Page 4, l. 11 – page 7, l. 7).

RESPONSE: Appellant’s argument with respect to Fung is moot in view of the above new ground of rejection.

2. Motive to Combine - Appellant believes motivation for the specific combination of elements in the cited references is lacking based on combining Wilf with Fung (page 8, ll. 15-25).

RESPONSE: The replacement of the Fung reference with Appellant admitted well known status of the claim limitation makes this argument moot regarding the Fung reference. However, Wilf expresses a motivation for accepting well known art, namely to establish an automated purchasing method which includes efficient automated web based steps and conveniences for validating the payment for an online transaction without exposing the customer’s personal information by maintaining security due to the reluctance of some users to transmit credit card account information over the internet (Wilf, Col. 1, ll. 24-27).

3. GENERAL RESPONSE: As recited by Appellant, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference

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teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). MPEP 2143, p. 2100-124, end – p. 2100-125, 1st 2 paragraphs.

In this case, first, the motivation for the case of obviousness is established based on the knowledge of the ordinary practitioner. Second, the expectation for success is documented by Wilf's teaching. Third, all of the claimed limitations are taught by the prior art reference or are admittedly well known to the ordinary practitioner at the time of Appellant's invention. As such, the *prima facie* case of obviousness has been properly established.

D. ARGUMENT: Re. Claims 8 and 16, Appellant argues that Fung is inappropriate prior art, and that the motive to add Kolling to any combination is lacking, and that an express showing of documentary proof is requested (page 9, II. 3-12).

RESPONSE: As is established above, the Fung reference has been replaced with Appellant admission that the limitation in question was well known at the time of Appellant's invention. Further, a motivation to combine Wilf with Kolling is stated in Kolling, namely to protect a vendor from undue delay in verifying such a transaction while minimizing costs, maintaining certain controls and discretionary actions on behalf of the biller, and simplifying the process for all the parties (Kolling, Col. 10, II. 25-62).

For the above reasons, it is believed that the rejections should be sustained.

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Respectfully submitted,

Siegfried E. Chencinski

Patent Examiner

May 13, 2005

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